

2000P07567US01
60,427-236**REMARKS****Double Patenting**

The Examiner provisionally rejected claims 1-4 under the judicially created Doctrine of Obviousness-Type Double Patenting as being unpatentable over claims 1 and 8 of Application No. 2001-0046300 in view of *Matsui*, U.S. Patent No. 4,506,380. Applicant notes that this application has been abandoned. Accordingly, the rejection of double patenting does not apply to any of the claims of the currently pending application. Therefore, the rejection of claims 1-4 and 12-16 for double patenting should be withdrawn.

Claim Rejections – 35 U.S.C. §102

The Examiner rejected claims 12-16 pursuant to 35 U.S.C. §102 as being anticipated by *Shibata, et al.*, U.S. Patent No. 5,581,619. Applicant has amended claim 12 and believes these claims and its dependents, claims 13-16 and new claim 21, stand in condition for allowance.

Specifically, claim 12 requires, “comparing the engine noise to the background sound” and “ceasing the generation of the noise cancelling signal based upon the comparing of the engine noise to the background sound.” This feature is not shown by *Shibata, et al.*, which teaches at best only the sensing of engine noise and background noise, not the comparison of the two sounds. Accordingly, claim 12 and its dependents, claims 13-16 and 21, stand in condition for allowance.

In additional claim 13 requires, “wherein the comparing of the engine noise to the background sound comprises a ratio of the engine noise to the background sound.” There

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is no mention of *Shibata, et al.* of a comparison by examining the ratio of engine noise to background sound. Accordingly, claim 13 is separately allowable.

Claim 14 depends upon claim 13 and further requires, "wherein ceasing the generation of the noise cancelling signal is conditioned upon the ratio being below a predetermined level." Claim 14 is in condition for allowance because it depends on claim 13. In addition, there is no mention in *Shibata, et al.* of ceasing the generation of the noise cancelling signal when the ratio is below a predetermined level.

Claim 15 depends upon claim 14 which is allowable for the reasons stated above. In addition, claim 15 requires, "the step of generating the noise cancelling signal when the ratio exceeds the predetermined level." *Shibata, et al.* did not teach this feature. Therefore, claim 15 is separately allowable.

Claim 16 has been amended to depend upon claim 14 and is allowable for this reason alone. In addition, claim 16 requires, "the step of recording when the ratio is below the predetermined level." This feature is not taught by *Shibata, et al.* Therefore, this claim is in condition for allowance.

New claim 21 depends upon claim 16 and is allowable for this reason. In addition, claim 21 requires, "wherein ceasing the generation of the noise cancelling signal is conditioned upon a predetermined number of instances of the recording of the ratio below the predetermined level." This feature is not disclosed in *Shibata, et al.* Therefore, claim 21 is in condition for allowance.

The Examiner rejected claims 1-4 under 35 U.S.C. §103(a) as being unpatentable over *Shibata, et al.* in view of *Matsui*. Claim 1 has been amended to overcome this rejection. Specifically, claim 1 requires, "ceasing the generating of the noise cancelling

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signal based upon the throttle position and the comparing of engine noise to background sound.” There is no teaching in *Shibata, et al.* or *Matsui* either alone or in combination of ceasing the generation of the noise cancelling signal based upon both throttle position and the comparison of engine noise to background sound. Therefore, claim 1 and its dependents, claim 4, new claim 22 and new claim 23, stand in condition for allowance.

Claim 4 depends upon claim 1 and is in condition for allowance because of this dependence. In addition, claim 4 requires, “the engine noise and the background sound are related by a ratio.” The Examiner contends that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of *Shibata, et al.* by providing a ratio for the purpose of providing numerical representation of similarities of engine noise and background sound. However, neither *Shibata, et al.* and *Matsui* disclose this feature nor do they disclose ceasing the generation of the noise cancelling signal based upon this ratio. Applicant requests the Examiner provide a prior art reference showing this feature as well as provide motivation for its combination with *Shibata, et al.* and *Matsui*. Claim 4 is distinguished by this feature and is therefore in condition for allowance.

New claim 22 depends upon claim 4 and requires, “the ceasing of the generation of the noise cancelling signal is conditioned upon the ratio being greater than a predetermined level and the throttle position being less open than a predetermined position.” This feature is not shown by *Shibata, et al.* and *Matsui*, either alone or in combination. Therefore, new claim 22 is in condition for allowance for this additional reason.

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New claim 23 depends upon dependent claim 22, which is in condition for allowance. Claim 23 requires, "the step of generating the noise cancelling signal when the throttle position is greater than the predetermined position." This feature is not shown by *Matsui* or *Shibata, et al.*, either alone or in combination. Therefore, new claim 23 is in condition for allowance.

For the foregoing reasons, Applicant requests allowance of all pending claims.

Respectfully submitted,

CARLSON, GASKEY & OLDS

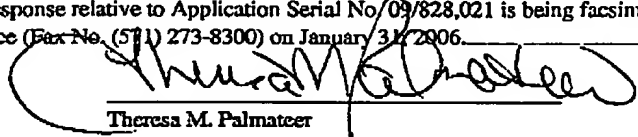
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CERTIFICATE OF FACSIMILE

I hereby certify that this Response relative to Application Serial No. 09/828,021 is being facsimile transmitted to the Patent and Trademark Office (Fax No. (571) 273-8300) on January 31, 2006.


Theresa M. Palmateer

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